

Appl. No. : 09/575,199
Filed : May 18, 2000

REMARKS

Claims 1-3, 5-11, 13-21, 25, and 35-74 are pending in the application. Claims 1, 2, 14, 15, 17, and 25 have been amended. No new matter has been introduced with these amendments and support for the amendments can be found in the original claims as filed and throughout the specification as filed. Entry of these amendments is requested. Claims 35-74 have been cancelled without prejudice. Applicants reserve the right to pursue the subject matter of these claims in a continuation or divisional filing.

Objection and Rejection of Claims 1-3, 5-11, 13-21, and 25 under 35 U.S.C. § 112

The Examiner has rejected Claims 1-3, 5-11, 13-21, and 25 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for a number of reasons. Each rejection or objection is discussed below.

The Examiner alleged that Claim 1 was unclear because the word "each" had been deleted from the claim. Claim 1 has been amended to recite a VEGF dimer wherein each monomer comprises "an amino acid sequence having at least about 90% sequence identity with amino acids 11 to 116 of SEQ ID NO: 1, retaining a cysteine (Cys) at or corresponding to position 116 of SEQ ID NO: 1 (Cys-116)," and other structural features recited in the claim. Thus, both the first and second monomers are defined in the claims as amended.

Claims 1, 2, 14, 15, and 17 have been amended to specify the location of the Cys residue referred to in each of these claims. These amendments obviate the objections raised by the Examiner that recitation of "the Cys" lacks antecedent basis.

Regarding the observation of the Examiner pertaining to the eliminated glycosylation site, Claims 1 and 14 have been amended to clarify this limitation. Applicants submit that these amendments obviate the Examiner's rejection.

In view of these comments, Applicants submit that rejected Claims 1-3, 5-11, 13-21, and 25 are in condition for allowance.

The pending claims are novel

Claims 1-3, 5-11, 13-21, and 25 were finally rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Tischcer, et al., U.S. Patent No. 5,194,596 (filed in 1989, issued in 1993). The Examiner notes in the final Action that Tischcer allegedly anticipates the pending claims

because Tischer discloses the production of a VEGF variant in *E. coli* cells that are incapable of glycosylation. The Examiner further alleged that because Tischer disclosed that there was no evidence that glycosylation was essential for biological activity, that non-glycosylated forms of VEGF were disclosed by Tischer. Although the Examiner may be correct regarding her characterization of the Tischer reference, this reference does not anticipate the rejected claims.

To be anticipatory under 35 U.S.C. § 102, a reference must teach each and every element of the claimed invention. *See Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). "Invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. ...There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991).

Tischer fails to anticipate the claimed invention because the reference does not teach each and every limitation of the claimed invention. Tischer does not teach a VEGF variant dimer that lacks a glycosylation site at or corresponding to positions 75-77 of SEQ ID NO: 1. Tischer reportedly produced VEGF that was not glycosylated. However, the glycosylation site in the VEGF molecules used by Tischer contained a glycosylation site. Because Tischer used a VEGF molecule that has a different amino acid sequence from that claimed presently claimed, Tischer cannot anticipate the pending claims. Thus, the art cited against the pending claims is not anticipatory as it fails to teach all the limitations of the claims. As such, Applicants request that this rejection be withdrawn.

CONCLUSION

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is requested. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

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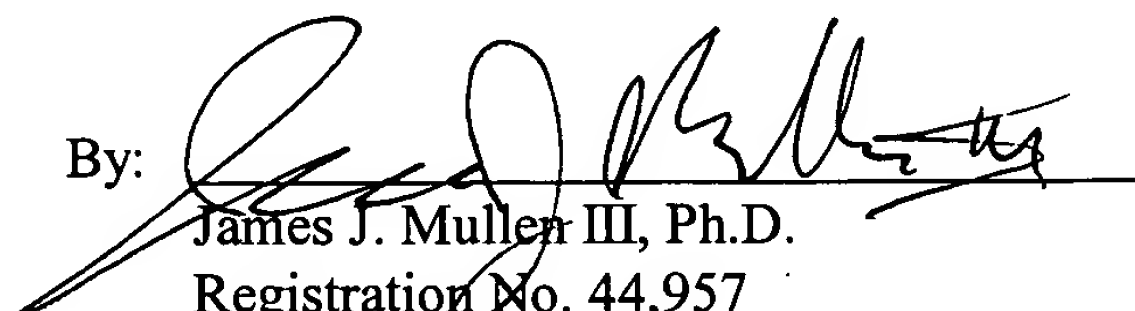
Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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